Attorney's Docket No. 35800/204489 (5800-28A)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Robison *et al.*		
Appl No.:	09/668,266	Group Art Unit:	1655
Filed:	September 22, 2000	Examiner:	B. Sisson
For:	22025, A NOVEL HUMAN CYCLIC NUCLEOTIDE PHOSPHODIESTERASE		

February 12, 2001

Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated January 10, 2000, in which the Examiner has required restriction between Group I, namely claim 1, Group II, namely claim 2, Group III, namely claim 3, Group IV, namely claims 4-9 and 13, Group V, namely claims 10-12, Group VI, namely claim 14, and Group VII, namely claims 15-18. Applicant hereby provisionally elects with traverse to prosecute the claim of Group I (claim 1) and expressly reserves the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims.

Group I is drawn to an isolated polypeptide. It is submitted that the search required to determine the patentability of the compositions of Group I is essentially the same search that would be required for Group III, drawn to methods for producing the polypeptide of Group I, and Group IV, drawn to methods of detecting the polypeptide of Group I and a kit for detecting the polypeptide of Group I. These methods of Group III and Group IV specifically recite the same polypeptide as Group I. 37 CFR §1.142 requires that the inventions be "independent and

distinct." According to MPEP 802.01, "independent" requires that there is no disclosed relationship between the two or more subjects disclosed. The relationship of Groups I and III, and IV do not meet this standard. In fact, the polypeptides required in the methods are identical to the polypeptides of the composition claim. Therefore, it is requested that the Examiner reconsider and examine Groups I and III, and IV together.

It is further submitted that a search of the amino acid sequence of Group I will reveal information relevant to the method for detecting the presence of any of the nucleotide sequence encoding the polypeptides of this group recited in Group V. As the Examiner is aware, the polypeptides of Group I and the nucleotide sequences which encode them are related. Thus, Groups I and V should be considered together. MPEP 803 sets forth that "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants submit that the consideration of Groups I and V together will not be a burden on the Examiner. The issues surrounding the polypeptide claims and the methods for detecting the nucleotide sequences encoding them are essentially the same and thus should be considered together.

For these reasons, it is requested that the Examiner reconsider and examine Groups I, III, IV, and V together.

The Office Action states that the above-referenced application appears to be a continuation application, not a divisional application of U.S. Patent Application 09/330,970 (now US Patent No. 6,146,876). U.S. Patent Application 09/330,970 was subject to restriction

requirement, and Applicants elected to prosecute the claims of Group III, directed to nucleic acid sequences, vectors, and host cells, in this parent application. The claims of the present application correspond to non-elected groups of U.S. Patent Application 09/330,970, and thus the present application is a divisional application of 09/330,970. A Preliminary Amendment, submitted concurrently herewith, directs correction of the specification with respect to cross-references to related applications. A copy of a Request for Corrected Filing Receipt submitted to the Office of Initial Patent Examination is also included with this response.

The Office Action states that page 2 of the Transmittal sheet indicated that an Information Disclosure Statement (IDS) has been filed, but that no IDS is associated with the application. Applicant herewith transmits the requested IDS and PTO Form 1449.

The Office Action states that the application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reasons set forth on the Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures. Applicant herewith submits a response to the Notice to Comply along with a paper copy of the Sequence Listing as well as a Computer Readable Format (CRF) of the Sequence Listing.

Should the Examiner have further questions or comments with respect to examination of this case, it is respectfully requested that the Examiner telephone the undersigned attorney so that further examination of this application can be expedited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner For Patents, Washington, DC 20231, on February 12, 2001.

Nora C Martinez

Nora C. Martinez